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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,411	08/01/2000	Eitan Farchi	FARCHI 1	5929

7590 11/04/2003

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EXAMINER	
GROSS, KENNETH A	

ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/630,411	FARCHI ET AL.	
	Examiner	Art Unit	
	Kenneth A Gross	2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-35 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-35 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, there exist certain discrepancies between Claim 1 and its dependent Claim 2. Claim 1 is an independent Claim teaching a method for automatically invoking at least one predetermined debugger command at a desired location of a program by means of a utility that reads a trace file. Claim 2 narrows the scope of Claim 1 by teaching he function of the utility when it is executed in step (b) of Claim 1. The issues in these Claims are: (a) how and when the trace file is created; and (b) how and when a debugger command is placed in trace file. Similar inconsistencies exist in Claims 7, 18-24, and 28.

Claim 1 teaches a "utility which reads a trace file in which said at least one predetermined debugger command has been previously embedded." This language suggests that a trace file already exists and that a debugger command is already in place when the utility is embedded in the program. Claim 2, however, states "if the trace file does not exist on entry to the utility, (the utility) creates the trace file". This seems to contradict Claim 1, and makes ambiguous when exactly the trace file is created. If a debugger command is embedded into the trace file *previously*, then shouldn't the trace file always exist when the utility is run?

Furthermore, if the value of at least one variable is written to the trace file when the trace file is created, when is debugger command written to the trace file? Is it before or after the variable values are written to the trace file?

In the amendment filed on August 7th, 2003, the applicant states that debugger commands are inserted into the trace file after the variable values are written to the trace file and before the program is run again to execute the debugger commands in step (iii) of Claim 2. Claim 1, however, states that the debugger commands are "previously embedded" in the trace file, and not embedded in the trace file in order to replace variable values written to the trace file in step (ii) of Claim 2. Claim 2 attempts to clarify this by stating, "step (a) includes modifying the trace file so as to replace or insert at least one trace value with the predetermined debugger command". However, Claim 1 makes no reference to traced values. Furthermore, the amendment states on page 18, lines 15-17) that "Claim 2 does not require that the program variables in the trace file be replaced or augmented: if they are not, then the debugger will simply not be invoked." However, this seems to contradict the Claim that at least one debugger command has been previously embedded in the trace file. So, the trace file *must* contain at least one debugger command, and hence the debugger will always be invoked.

Finally, Claim 2 recites, "whereby upon running the program prior to carrying out said method". It is unclear from this language what exactly "said method" refers to. Does this refer to the method steps of (i)-(iii) in Claim 2? If so, how can the utility trace variables to the trace file, if the trace file does not yet exist (since it is created in step (ii))?

Claims 3-6, 8-17, 25-27, and 29-35 are rejected for being dependent on a rejected parent Claim.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, Claim 2 recites, "modifying the trace file so as to replace or insert at least one traced value with the predetermined debugger command". It's not understood from this language what it means to "insert at least one traced value with the predetermined debugger command".

Claims 3-6 are rejected for being dependent on a rejected parent Claim.

5. In light of these 35 U.S.C. 112 issues, a lack of rejection based on prior art to a particular claim should not be construed as an impending allowability of that claim.

Conclusion

6. Note that the PTO 1449 Form (Information Disclosure Statement) appears to be missing from the application. Please resend a copy of this form, or fax a copy and your earliest convenience.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth A Gross whose telephone number is (703) 305-0542. The examiner can normally be reached on Mon-Fri 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

KAG

TUAN DAM
SUPERVISORY PATENT EXAMINER